



Atty. Dkt. No. 047071-0107

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Harry A. ATWATER, Jr. et al.

Title: WAFER BONDED VIRTUAL
SUBSTRATE AND METHOD
FOR FORMING THE SAME

Appl. No.: 10/761,918

Filing Date: 1/20/2004

Examiner: Duy-Vu DEO

Art Unit: 1765

Confirmation 4108
Number:

TERMINAL DISCLAIMER 2

Mail Box AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Your Petitioner, California Institute of Technology, having its principal place of business at 1200 East California Boulevard, Pasadena, California, represents that it is the owner of the entire right, title, and interest in and to U.S. Patent Application No. 10/761,918, filed 1/20/2004, which is a continuation-in-part of U.S. Patent Application No. 10/125,133, filed 4/17/2002, by virtue of an Assignment filed and recorded on 7/15/2004, on Reel/Frame 015566/0827, in the United States Patent and Trademark Office, a copy of which is attached hereto as APPENDIX A.

Further, your Petitioner represents that it is the owner of U.S. Patent Application No. 11/004,948, filed 12/7/2004, which is a continuation of U.S. Patent Application No. 10/761,918, filed 1/20/2004, which is a continuation-in-part of U.S. Patent Application No. 10/125,133 filed 4/17/2002, by virtue of an Assignment filed and recorded

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on 7/15/2004, on Reel/Frame 015566/0827, in the United States Patent and Trademark Office, a copy of which is attached hereto as APPENDIX A.

Your Petitioner, California Institute of Technology, hereby disclaims the terminal part of the term of any patent granted on U.S. Patent Application 10/761,918 which would extend beyond the full statutory term, as shortened by any terminal disclaimer, of any patent granted on U.S. Patent Application 11/004,948, and hereby agrees that any patent so granted on U.S. Patent Application 10/761,918 shall be enforceable only for and during such period that the legal title to any patent granted on U.S. Patent Application 11/004,948 shall be the same as the legal title to any patent granted on U.S. Patent Application 10/761,918, this agreement to run with any patent granted on U.S. Patent Application 10/761,918 and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioner does not disclaim any terminal part of any patent granted on U.S. Patent Application 10/761,918, prior to the full statutory term of any patent granted on U.S. Patent Application 11/004,948 as defined in 35 U.S.C. §§154-156 and 173, in the event that any patent granted on U.S. Patent Application 11/004,948 expires for failure to pay a maintenance fee, is held unenforceable or is found invalid in a final judgment by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR §1.321(a), has all claims canceled by a reexamination certificate or as a result of an interference proceeding, or is otherwise not deemed to provide the rights conveyed by 35 USC §154, prior to the full statutory term of any patent granted on U.S. Patent Application 11/004,948 as defined in 35 USC §§154-156 and 173, except for the separation of legal title stated above. Further, Petitioner does not disclaim any terminal part of a patent granted on U.S. Patent Application 10/761,918 that would extend beyond the present termination of any patent granted on U.S. Patent Application 11/004,948, in the event that such present term is extended by virtue of compliance with the conditions for term extension of any present or future patent term extension provisions of the patent law, including but not limited to 35 U.S.C. §§155, 155A or 156, and without waiving Petitioner's right to extend the term of a patent granted on U.S. Patent Application 10/761,918 to the extent provided by law.


The undersigned, being the Attorney of Record for U.S. Patent Application 10/761,918, and duly authorized to act on behalf of Petitioner, certifies that he has reviewed the Assignments attached as APPENDIX A, and to the best of his knowledge and belief, legal title to U.S. Patent Application 10/761,918 and any patent granted on U.S. Patent Application 11/004,948 rests with Petitioners, California Institute of Technology. The undersigned declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing therefrom.

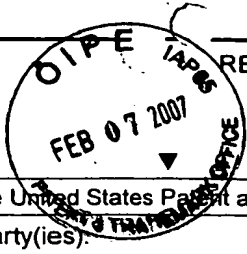
Respectfully submitted,

Date 2/7/07

By 

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cket No.: CIT.PAU.05A

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

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To the Director of the United States Patent and Trademark Office: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Harry A. Atwater, Jr.
Anna Fontcuberta i Morral
James M. Zahler

Additional names(s) of conveying party(ies) ☐ Yes ☐ No

3. Nature of conveyance:

- ☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other _____

Execution Date: 04/21/04; 04/19/04; 04/19/04

2. Name and address of receiving party(ies):

Name: California Institute of Technology

Internal Address: _____

Street Address: 1200 East California Boulevard

City: Pasadena State: CA ZIP: 91125

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent numbers(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s)

10/761,918

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Daniel L. Dawes

Internal Address: MYERS DAWES ANDRAS &
SHERMAN LLP

Street Address: 19900 MacArthur Boulevard, Suite 1150

City: Irvine State: CA ZIP: 92612

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR 3.41):.....\$ 40.00

- ☒ Enclosed - Any excess or insufficiency should be credited or debited to deposit account 01-1960
☐ Authorized to be charged to deposit account

8. Deposit account number: _____

(Attach duplicate copy of this page if paying by deposit account)

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9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Daniel L. Dawes

Name of Person Signing


Signature

July 14, 2004

Date

Total number of pages including cover sheet, attachments, and document: 4

Mail documents to be recorded with required cover sheet information to:

Mail Stop Assignment Recordation Services

Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450

CIT.PAU.05a

ASSIGNMENT

CIT Case No. 3453-2

For good and valuable consideration, the receipt of which is hereby acknowledged, ASSIGNOR(S),

Harry A. Atwater Jr.

hereby sells, assigns and transfers to ASSIGNEE, California Institute of Technology, having its statewide administrative offices located at 1200 East California Boulevard, Pasadena, California 91125, and the successors, assigns and legal representatives of the ASSIGNEE, all of its rights, title and interest for the United States and its territorial possessions and in all foreign countries in and to, any and all improvements which are disclosed in the invention entitled:

A Water Bonded Virtual Substrate and Method for Forming the Same

and which is found in

(a) _____ U.S. provisional application filed herewith and listing the above named persons as inventors

(b) _____ U.S. patent application filed herewith and listing the above named persons as inventors

(c) ☒ U.S. application serial no. 10/761,918, filed on 01/20/2004

(d) _____ U.S. Patent No.: _____, issued _____

and any legal equivalent thereof in a foreign country, including the right to claim priority and, in and to, all Letters Patent to be obtained for said invention by the above application or any continuation, division, continuation-in-part, extension, conversion to 35 USC 111(a) or substitute thereof, and any reissue, reexamination or extension of said Letters Patent and all under all International Conventions for the Protection of Industrial Property;

ASSIGNOR(S) hereby covenants that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment;


ASSIGNOR(S) further covenants that the ASSIGNEE will, upon its request, be provided promptly with all pertinent facts and documents relating to said invention and said Letters Patent and legal equivalents as may be known and accessible to ASSIGNOR and will testify as to the same in any interference, litigation, or proceeding relating thereto and will promptly execute and deliver to ASSIGNEE or its legal representative any and all papers, instruments or affidavits required to apply for, obtain, maintain, issue or enforce said application, said invention and said Letters Patent and said equivalents thereof which may be necessary or desirable to carry out the purposes thereof. An attorney of record is authorized and requested by the execution of this assignment to insert into this assignment the filing date and serial number of said application when officially known.

AND the ASSIGNOR(S) requests the Commissioner of Patents and Trademarks to issue said Letters Patent of the United States and any reissue or extension thereof to the ASSIGNEE, California Institute of Technology.

executed this

19th day of April, 2004

Signature of Inventor(s)


Harry A. Atwater Jr.

BEST AVAILABLE COPY

ASSIGNMENT

CIT Case No. 3453-CIP

For good and valuable consideration, the receipt of which is hereby acknowledged, ASSIGNOR(S),

James M. Zahler

hereby sells, assigns and transfers to ASSIGNEE, California Institute of Technology, having its statewide administrative offices located at 1200 East California Boulevard, Pasadena, California 91125, and the successors, assigns and legal representatives of the ASSIGNEE, all of its rights, title and interest for the United States and its territorial possessions and in all foreign countries in and to, any and all improvements which are disclosed in the invention entitled:

A Wafer Bonded Virtual Substrate and Method for Forming the Same

and which is found in

(a) ____ U.S. provisional application filed herewith and listing the above named persons as inventors

(b) ____ U.S. patent application filed herewith and listing the above named persons as inventors

(c) X U.S. application serial no. 10/761,918, filed on 01/20/2004

(d) ____ U.S. Patent No.: _____, issued _____

and any legal equivalent thereof in a foreign country, including the right to claim priority and, in and to, all Letters Patent to be obtained for said invention by the above application or any continuation, division, continuation-in-part, extension, conversion to 35 USC 111(a) or substitute thereof, and any reissue, reexamination or extension of said Letters Patent and all under all International Conventions for the Protection of Industrial Property;

ASSIGNOR(S) hereby covenants that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment;

ASSIGNOR(S) further covenants that the ASSIGNEE will, upon its request, be provided promptly with all pertinent facts and documents relating to said invention and said Letters Patent and legal equivalents as may be known and accessible to ASSIGNOR and will testify as to the same in any interference, litigation, or proceeding relating thereto and will promptly execute and deliver to ASSIGNEE or its legal representative any and all papers, instruments or affidavits required to apply for, obtain, maintain, issue or enforce said application, said invention and said Letters Patent and said equivalents thereof which may be necessary or desirable to carry out the purposes thereof. An attorney of record is authorized and requested by the execution of this assignment to insert into this assignment the filing date and serial number of said application when officially known.

AND the ASSIGNOR(S) requests the Commissioner of Patents and Trademarks to issue said Letters Patent of the United States and any reissue or extension thereof to the ASSIGNEE, California Institute of Technology.

executed this

Signature of Inventor(s)

21ST day of April, 20 04James M. Zahler

ASSIGNMENT

CIT Case No. 3453-CIP

For good and valuable consideration, the receipt of which is hereby acknowledged, ASSIGNOR(S),

Anna Fontcuberta i Morral

hereby sells, assigns and transfers to ASSIGNEE, California Institute of Technology, having its statewide administrative offices located at 1200 East California Boulevard, Pasadena, California 91125, and the successors, assigns and legal representatives of the ASSIGNEE, all of its rights, title and interest for the United States and its territorial possessions and in all foreign countries in and to, any and all improvements which are disclosed in the invention entitled:

A Wafer Bonded Virtual Substrate and Method for Forming the Same

and which is found in

(a) ____ U.S. provisional application filed herewith and listing the above named persons as inventors

(b) ____ U.S. patent application filed herewith and listing the above named persons as inventors

(c) X U.S. application serial no. 10/761,918, filed on 01/20/2004

(d) ____ U.S. Patent No.: _____, issued _____

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AND the ASSIGNOR(S) requests the Commissioner of Patents and Trademarks to issue said Letters Patent of the United States and any reissue or extension thereof to the ASSIGNEE, California Institute of Technology.

executed this

Signature of Inventor(s)

19th day of April, 2004

Anna Fontcuberta i Morral